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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,603	12/11/2003	Thomas Woodrow Wilson III	4022-000016	8214
27572	7590	07/14/2006	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C.			SANDERS, KRIELLION ANTIONETTE	
P.O. BOX 828			ART UNIT	
BLOOMFIELD HILLS, MI 48303			PAPER NUMBER	

1714

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,603

Applicant(s)

WILSON, THOMAS WOODROW

Examiner

Kriellion A. Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The rejection of claims 54-60 under 35 USC § 112 is withdrawn in view of applicant's amendment.

Applicant's arguments with respect to claims 1-60 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-7 and 9- 43 are rejected under the judicially created doctrine of double patenting over claims 1-60 of U. S. Patent No. 6620871, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as set forth below.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Applicant's invention pertains to a rubber composition comprising:

1. Natural rubber, synthetic rubber or mixtures, such as butyl rubber, halogenated rubbers and millable polyurethanes
2. A curing agent
3. A silica filler
4. A non-petroleum oil having fatty acid side chains wherein at least half of the side chains are unsaturated, such as
 - a. Castor oil

The composition may additionally comprise a sulfur curing agent.

The composition may additionally comprise a metal alkoxy compound, wherein the metal is

- i. Titanium
- ii. Zirconium
- iii. A chelate

Claims 16-27 are directed to a rubber composition wherein the rubber is cured and articles made therefrom such as a shoe.

Claims 28-33 relate to a method for producing a rubber footwear article.

Claims 34-53 and 60 relate to a shoe having a component made from the presently claimed rubber composition.

Wilson, III discloses a moldable rubber composition containing a synthetic or natural rubber, conventional curing agents, and an auxiliary composition containing titanium or zirconium compounds. The titanium compounds of the invention have at least one alkoxy group bonded to titanium, and zirconium compounds of the invention have at least one alkoxy group bonded to zirconium. In preferred embodiments, the auxiliary composition contains chelates of the titanium or zirconium compound.

The rubber resin of the patented invention may be selected from the group consisting of natural rubber, synthetic rubber, and mixtures thereof, wherein the synthetic rubber comprises a backbone comprising repeating olefinic unsaturation. The composition additionally contains a sulfur containing curing agent and an auxiliary composition comprising petroleum wax.

Suitable amounts of metal compounds are expressed as 0.01-10 phr resin of a metal compound selected from the group consisting of a titanium compound with at least one alkoxy group -OR bonded to titanium, a zirconium compound with at least 1 alkoxy group OR bonded to zirconium, and mixtures thereof. 0.01-10 parts per hundred resin of a metal compound selected from the group consisting of a titanium compound with at least one alkoxy group --OR bonded to titanium, a zirconium compound with at least one alkoxy group -OR bonded to zirconium, and mixtures thereof, wherein R comprises an alkyl group of 8 or fewer carbon atoms. Examples of the metal compound include titanium acetylacetonate and zirconium acetylacetonate.

The patented composition further includes a carrier that comprises silica, wherein the carrier comprises carbon black or wherein the carrier comprises titanium dioxide. The patented composition may further 40 to 48 phr silica filler and/or a petroleum wax.

The patented invention further calls for a method for producing a rubber footwear component, wherein the molded rubber article is a shoe outsole, comprising mixing a moldable rubber composition comprising a rubber resin selected from the group consisting of natural rubber, synthetic rubber and mixtures thereof, wherein the synthetic rubber comprises a backbone comprising repeating olefinic unsaturation a sulfur containing curing agent; and a metal compound. The patented invention includes less than 3 phr of a non-petroleum oil. The iodine number is considered to be an inherent property of the compositions since the components of the patented invention are essentially the same as applicant's, the properties of the composition are expected to be the same as the properties of applicant's composition. See the entire document.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-60 of U.S. Patent No. 6620871 as applied to claims 1- 43 above and further in view of Teratani et al, US Patent No. 5001185 and Hakuta et al, PG PUB- No. 20030096904.

1. Teratani et al discloses a rubber composition comprising 20-130 parts by weight of carbon black and 1-30 parts by weight of at least one resin obtained by adding amine as a curing agent to a novolak type phenolic resin modified with at least one of animal oil, vegetable oil, unsaturated oil, aromatic hydrocarbon and nitrile rubber for the provision of self curability, based on 100 parts by weight of at least one rubber selected from polyisoprene rubber (inclusive of natural rubber), polybutadiene rubber and styrene-butadiene copolymer rubber. According to the patented invention, additives usually used in the rubber industry include sulfur, vulcanizing agent, vulcanization accelerator, antioxidant, silica and process oil. See col. 3, lines 19-24. Since these components are conventional their inclusion in the Wilson, III rubber compositions, (particularly the inclusion of the specific oils of Teratani et al), would have been obvious to the ordinary practitioner of this art.

Hakuta et al teaches castor oil to be an effective dripping inhibitor for rubber compositions. See paragraph 0569. Incorporation of the conventional castor oil into the compositions of Wilson, III to function as a dripping inhibitor would have been an obvious variation to one of ordinary skill in the art absent a clear showing of unexpected results attributable to the specific oil employed.

Furthermore, since Wilson, III indicates that conventional curing agents may be used to cure the rubber compositions, and Hakuta et al teaches castor oil to be an effective dripping inhibitor as well as a filler for rubber compositions, it would have been obvious to the ordinary practitioner to use any conventional curing agent including those of the peroxy type, absent some clear showing of unexpected results attributable to this selection.

Response to Arguments

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1. Applicant's arguments filed 4/24/06 have been fully considered but they are not persuasive. All rejections set forth herein have been argued by applicant to be improper based upon applicant's amendment to the claims. Applicant argues that the claims now require the presence of the non-petroleum oil. In response to applicant's argument that the references fail to show this feature of applicant's invention, it is noted that the features upon which applicant relies (i.e., the required presence of the non-petroleum oil) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's claim language reads that the non-petroleum oil is present at a level of 5phr or less. This may be interpreted to read that the non-petroleum oil is present at a phr of 0.0, since anything less than 5 phr is encompassed by the present claim terminology. The rejections are therefore repeated.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122.

The examiner can normally be reached on Monday through Thursday 6:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kriellion A. Sanders
Primary Examiner
Art Unit 1714